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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,448	07/01/2002	Ikunori Azuse	020248	7562

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,448	Applicant(s) AZUSE ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 15-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

This application is before the examiner for consideration.

- I. In view of the complexity of the claims as set up, this Office action is made.
- II. The specification has been amended. Applicants fail to (1) state that no new matter has been added and (2) clearly and precisely point out a support with page number and line number for each of the embodiments as added. Accordingly, if a new matter is found, please see the authority as stated in *Tronzo v. Biomet Inc.*, 4 USPQ2d 1403.
- III. The record shows that the claims in the instant application are a combination from multiple Japanese priority applications.
- IV. They are, however, not considered to be patentably different or distinct because they are all depended on the method claims. Therefore, no restriction is made. Accordingly, the broadest elected species method claim will be firstly and independently considered and searched. Others claims containing elected species are integrally considered and searched as set up. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as shown or urged.
- V.1. Claims 1-13 and 15-20 are generic to a plurality of disclosed patentably distinct species comprising many possible amphoteric surfactants of the general formulas (1), (2) and (3) in the

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art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are further required to made an elect of a sub-species such as compound A1 on page 52, line 23.

2. Claims 1-13 and 15-20 are generic to a plurality of disclosed patentably distinct species comprising many possible quaternary ammonium surfactants of the general formulas (4), (5) and (6) in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are further required to made an elect of a sub-species such as compound A2, on page 52, line 29

3. Claims 1-13 and 15-20 are generic to a plurality of disclosed patentably distinct species comprising many possible base oils in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species such as compound B1 on page 53, line 11 for an initiation of a search, even though this requirement is traversed.

4. Claims 1-13 and 15-20 are generic to a plurality of disclosed patentably distinct species comprising many possible anionic surfactants in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species such as compound A3 on page 53, line 6 for an initiation of a search, even though this requirement is traversed.

5. Claims 1-13 and 15-20 are generic to a plurality of disclosed patentably distinct species comprising many possible antitackiness agents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species such as compound C on page 53, line 21 for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the species to be examined even though the requirement be traversed (37 CFR 1.143).

VI. It is also recognize that there are also claims being related product-by process. A processing step in a product claim would have and be considered no value until applicants could be able to show that the claimed processing step must be ultimately provided an unusual or unexpected result over any prior or known elastic fiber. Otherwise the "product", elastic fiber per se, regardless its "-by-process" step as claimed would have and be given no value if one would be later show or provide it. It is now notified for the record. Please see at least the authority stated in *In re Brown*, 173 USPQ 685, *In re Thorpe*, 227 USPQ 964.

VII. Other issues have not been considered until a proper election is made and resolved.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
12 April 2004

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le